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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,792	04/13/2001	Robert F. Margolskee	AP32911 070165.0589	8395

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HEDMAN & COSTIGAN P C  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-2601

EXAMINER

TURNER, SHARON L

ART UNIT	PAPER NUMBER
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1647

13

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,792

Applicant(s)

MARGOLSKEE ET AL.

Examiner

Sharon L. Turner

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

***Election/Restriction***

1. The preliminary amendment filed 10-31-02 has been entered into the record and has been fully considered.
2. Claims 1-23 are pending.

**Improper Markush**

3. Prior to setting forth the restriction requirement, it is pointed out that applicants have presented instant claims in improper Markush format, see Ex parte Markush, 1925 C.D. 126, In re Weber, 198 USPQ 334 and MPEP 803.02 and 806.04. The claims are improperly set forth as the genus claims encompassing multiple products, as identified and claimed, fail to share the characteristics of a genus, i.e., a common utility and a substantial structural feature essential to the disclosed utility. Alternatively, the claims define multiple structurally distinct compounds capable of different use, with different modes of operation, different function and different effects. A reference against one of the claimed components or methods would not be a reference against the other. Therefore, the restriction will be set forth for each of the various groups, irrespective of the improper format of the claims, because the claims define inventions which are not proper species.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 and 15-16 drawn to nucleic acids, classified in class 536, subclass 23.1.
  - II. Claims 8-13 drawn to polypeptides, classified in class 530, subclass 300 and/or 350.
  - III. Claim 14 drawn to antibodies, classified in class 530, subclass 387.1.

Art Unit: 1647

- IV. Claim 17 drawn to a method of identifying a compound that induces the perception of a bitter taste, classified for example in class 435, subclass 5.
  - V. Claim 18 drawn to a method of identifying a compound that inhibits the perception of a bitter taste and/or promotes the perception of a sweet taste, classified for example in class 435, subclass 7.1.
  - VI. Claim 19 drawn to a method of identifying an inhibitor of bitter taste in vivo, classified for example in class 435, subclass 7.2.
  - VII. Claim 20 drawn to a method of identifying an activator of bitter taste in vivo, classified for example in class 436, subclass 518.
  - VIII. Claim 21 drawn to a method of inhibiting bitter taste, classified for example in class 424, subclass 93.1.
  - IX. Claim 22 drawn to a method of producing the perception of a sweet taste, classified for example in class 424, subclass 93.2.
  - X. Claim 23 drawn to a method of producing the perception of a bitter taste, classified for example in class 424, subclass 184.1.
5. Furthermore, in addition to the election of one of the above groups, further restriction is required under 35 U.S.C. 121 as set forth below to delineate the molecular embodiments to which the claims will be restricted in accordance with the elected group:
- A) A single designated nucleic acid composition selected from SEQ ID Nos: 1 and 3.
  - B) A single polypeptide selected from SEQ ID Nos:2 and 4.
6. The inventions are distinct, each from the other because of the following reasons:

7. Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because the products indicated as A-B constitute patentably distinct inventions for the following reasons. Each of the polynucleotides and polypeptides has unique structural features that require a unique search of the prior art. The inventions indicated as A-B differ in structure and function as they are composed of divergent nucleic and amino acids and are differentially able to hybridize, bind or mediate biological functions. A reference to one element would not constitute a reference to another. In addition, searching all of the molecules in a single patent application would provide an undue search burden on the examiner and the USPTO's resources because the indicated searches are not co-extensive.

8. Groups I-III are related as products. Each product is distinct from the other due to their distinct structures, i.e., nucleic acids, amino acids, and antibodies.

9. Groups IV-X are related as processes. Each process is distinct from the other due to their different steps, different reagents, different effects and different functional outcomes.

10. Inventions I-III and inventions IV-X are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case (1) the processes for using the products can be practiced with alternative nucleic acids, peptides, antibodies, organic and inorganic molecules and (2) the products can be used in alternative binding assays, competition assays, purification assays and in alternative methods of treatment.

Art Unit: 1647

11. Because these inventions are distinct for the reasons given above and the search required for any of the Groups is not required for any other Group, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.


13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

14. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.  
February 24, 2003

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**

Continuation of Attachment(s) 6). Other: CRF Problem Report & Notice to Comply.